

**REMARKS**

In the Final Office Action, the Examiner rejected claims 1, 7, 13, 15-18, 23, 26, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by *Ogilvie et al.*, U.S. Patent No. 6,344,796 ("*Ogilvie*"). The Examiner also rejected claims 8-10 and 31-34 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0118111 A1 of *Brown et al.* ("*Brown*"). Under 35 U.S.C. § 103(a), the Examiner rejected claims 2, 14, 20, 21, and 27 as being obvious over *Ogilvie* and claims 11 and 12 as being obvious over *Brown*. The Examiner further rejected claims 1-3, 5-7, 16, 17, 19, 20, 22, and 26-28 under 35 U.S.C. § 103(a) as being obvious over *Brown* in view of *Moreno*, U.S. Patent Application Publication No. 2002/0035515 A1 ("*Moreno*"). The Examiner also rejected claims 24 and 25 under 35 U.S.C. § 103(a) as being obvious over *Brown* in view of *Muhme*, U.S. Patent No. 5,886,634 ("*Muhme*"). Finally, the Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being obvious over *Brown* in view of *Moreno* further in view of *Muhme*.

By this paper, Applicant has amended claims 1, 2-4, 7, 8, 10, 13, 14, 16, 24, 29, and 31 to clarify aspects of the invention. Applicant has also cancelled claims 26-28 and 33-34 without prejudice or disclaimer of any subject matter.

*Section 102 Rejections*

Under 35 U.S.C. § 102(e), the Examiner rejected claims 1, 7, 13, 15-18, 23, 26, 29, and 30 as being anticipated by *Ogilvie* and rejected claims 8-10 and 31-34 as being anticipated by *Brown*. To anticipate a claim, a reference must teach every element of the claim. M.P.E.P. § 2131.01 (8<sup>th</sup> ed. 2001, revised February 2003). As amended, claims 1, 7, 8-10, 13, 15-18, 23, 26, 29, and 30-34 recite elements not disclosed in the

cited references. Accordingly, Applicant requests the reconsideration and withdrawal of the section 102 rejections of these claims.

For example, claim 1 recites a method of managing rental equipment including the step of automatically sensing status information about a customer's use of a piece of rental equipment from the piece or rental equipment when it is returned. The method of claim 1 further includes the step of billing the customer for use of the piece of equipment based on the status information sensed from the piece of rental equipment. *Ogilvie* does not teach at least these elements of claim 1. Instead, *Ogilvie* discloses an apparatus permitting unattended package delivery. (*Ogilvie*, Abstract.) In the Office Action, the Examiner alleged that "[t]he system of *Ogilvie* will record the fact that a given item has been removed...and this satisfies the limitation of 'status information.'" (4/28/05 Office Action, p. 3.) However, the system of *Ogilvie* merely assumes item delivery/removal whenever a user accesses a storage locker. (*Ogilvie*, col. 4, ll. 31-44.) The system of the reference does not automatically sense status information about a customer's use of a piece of rental equipment from the piece or rental equipment when it is returned. Further, the reference does not teach billing the customer for use of the piece of equipment based on the status information sensed from the piece of rental equipment. Because *Ogilvie* does not teach every element of amended claim 1, Applicant requests the withdrawal of the section 102 rejections of claim 1 and its dependent claim 7.

Claim 13, as amended, recites a method of managing rental equipment including the steps of automatically sensing status information about maintenance needed by a returned piece of equipment and billing the customer for costs associated with the

maintenance needed by the returned piece of equipment. *Ogilvie* does not disclose these claim elements. As discussed above with respect to claim 1, the system of *Ogilvie* merely assumes item delivery/removal whenever a user accesses a storage locker. It does not automatically sense status information about maintenance needed by a returned piece of equipment. Accordingly, Applicant requests the withdrawal of the section 102 rejections of claim 13 and its dependent claim 15.

Amended claim 16 recites a system for managing rental equipment including a status sensor that senses status information about operation of a piece of equipment in combination with an invoice component that bills a customer for operation of the piece of equipment based on the sensed status information. *Ogilvie* does not disclose this structure. As discussed above with respect to claim 1, the *Ogilvie* system does not sense status information about operation of a piece of equipment but instead assumes presence or absence of a package based on user access information. Because the reference does not teach every element of claim 16, Applicant requests the withdrawal of the section 102 rejections of claim 16 and its dependent claims 17, 18, and 23.

Claim 29 recites a system for providing goods to a customer including a sensor that detects maintenance needed by a piece of rental equipment returned by a customer and an invoice component that automatically bills the customer for costs associated with the needed maintenance. *Ogilvie* discloses a package delivery system and so would have no need for (and does not teach) detecting maintenance needed by a returned piece of rental equipment or automatically billing a customer for associated costs. Thus, Applicant requests the withdrawal of the section 102 rejections of claim 29 and its dependent claim 30.

Claim 8, as amended, recites a method of managing rental equipment including the steps of using a computer to sense starting status information related to operation of a piece of equipment and using a computer to sense return status information from the piece of equipment when a customer returns the piece of equipment. The method of claim 8 further includes the step of billing the customer for use of the piece of equipment based on the starting status information and the return status information. *Brown* does not teach such a method. Instead, *Brown* discloses a storage room which may monitor the presence or absence of items in inventory using RFID tags, video cameras, or weight-detecting shelves. (*Brown*, ¶¶ 0021-0024.) The system of *Brown* may replenish or bill for inventory items based on their removal from the storage room. (*Id.*, §¶ 0033.) However, nothing in the reference teaches sensing return status information from a piece of equipment when a customer returns the piece of equipment or billing a customer for use of the piece of equipment based on starting status information and the return status information. Therefore, Applicant requests the withdrawal of the section 102 rejections of claim 8 and its dependent claims 9 and 10.

Claim 31 recites a method including the steps of sensing status information related to the customer's use of a piece of equipment and automatically billing the customer for use of the piece of equipment in an amount based on the sensed status information. As discussed above with respect to claim 8, *Brown* merely teaches sensing the presence or absence of an item in inventory, not sensing status information related to the customer's use of a piece of equipment. Further, *Brown* only teaches billing based on the item's presence or absence, not on status information related to a customer's use of a piece of equipment. Because the reference does not teach every

element of claim 31, Applicant requests the withdrawal of the section 102 rejections of claim 31 and its dependent claim 32.

*Section 103 Rejections*

Under 35 U.S.C. § 103(a), the Examiner rejected claims 2, 14, 20, 21, and 27 as being obvious over *Ogilvie* and claims 11 and 12 as being obvious over *Brown*. The Examiner further rejected claims 1-3, 5-7, 16, 17, 19, 20, 22, and 26-28 as being obvious over *Brown* in view of *Moreno* and claims 24 and 25 under 35 U.S.C. § 103(a) as being obvious over *Brown* in view of *Muhme*. Finally, the Examiner rejected claim 4 as being obvious over *Brown* in view of *Moreno* further in view of *Muhme*. To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the reference or references must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001, Revised February 2003). This requirement must “be found in the prior art, and not be based on applicant’s disclosure.” *Id.* at § 2143.

*Ogilvie* fails to teach or suggest every element of amended claims 2, 14, 20 and 21, which depend from claims 1, 13, and 16. At least for the reasons discussed above with respect to these independent claims, the reference fails to render obvious dependent claims 2, 14, 20 and 21. Accordingly, Applicant requests the withdrawal of the section 103 rejections of claims 2, 14, 20 and 21.

*Brown* fails to teach or suggest every element of amended claims 11 and 12, which depend from claim 8. At least for the reasons discussed above with respect to independent claim 8, the reference fails to render obvious dependent claims 11 and 12. Accordingly, Applicant requests the withdrawal of the section 103 rejections of claims 11 and 12.

*Brown* and *Moreno*, taken alone or together, fail to teach or suggest every element of claims 1-3, 5-7, 16, 17, 19, 20, 22, and 26-28. For example, claim 1 and its dependent claims 2, 3, 5, 6, and 7 recite a method of managing rental equipment including the step of automatically sensing status information about a customer's use of a piece of rental equipment from the piece or rental equipment when it is returned. The method of claim 1 further includes the step of billing the customer for use of the piece of equipment based on the status information sensed from the piece of rental equipment. *Brown* does not teach at least these elements of the claims. Instead, *Brown* teaches a storage room that detects the presence or absence of items in inventory. (*Brown*, ¶ 0017.) Nothing in the reference teaches or suggests sensing status information about a customer's use of a piece of rental equipment from the piece or rental equipment when it is returned. Furthermore, *Moreno* does not cure these defects. Instead, *Moreno* discloses a storage locker system for securely delivering package, dry cleaning, pizzas, etc. (*Moreno*, § 0022.) Like *Brown*, *Moreno* fails even to suggest sensing status information about a customer's use of a piece of rental equipment from the piece or rental equipment when it is returned. Because *Brown* and *Moreno*, taken together or individually, fail to teach or suggest every element of amended claim 1, Applicant requests the withdrawal of the section 103 rejections of claim 1 and its dependent claims 2, 3, 5, 6, and 7.

Amended claim 16 and its dependent claims 17, 19, 20 and 22 recite a system for managing rental equipment including a status sensor that senses status information about operation of a piece of equipment in combination with an invoice component that bills a customer for operation of the piece of equipment based on the sensed status

information. For at least the reasons given above regarding claim 1, *Brown* and *Moreno* fail to teach or suggest these claim elements. Therefore, Applicant requests the withdrawal of the section 103 rejections of claim 16 and its dependent claims 17, 19, 20 and 22.

*Brown* and *Muhme* fail to teach or suggest every element of claims 24 and 25. As amended, claim 24 recites a system for managing rental equipment including a sensor that senses starting status information and return status information about operation of a piece of equipment and a computer that automatically creates a bill in an amount based on the starting status information and return status information. For at least the reasons given above with respect to claim 1, *Brown* fails to teach or suggest these claim elements. *Muhme* fails to cure this defect. *Muhme* merely discloses a system that reads ID tags on items and determines whether the items may be removed from a secure location. (*Muhme*, Abstract.) The reference merely controls item removal and does not teach or suggest senses starting status information, sensing return status information about operation of a piece of equipment, or automatically creating a bill in an amount based on the starting status information and return status information. Because neither *Brown* nor *Muhme*, taken together or separately, teaches every element of claim 24, Applicant requests the withdrawal of the section 103 rejections of claim 24 and dependent claim 25.

Finally, *Brown*, *Moreno*, and *Muhme*, taken together or alone, fail to teach or suggest every element recited by claim 4. Claim 4 depends from claim 1, which is nonobvious over *Brown* and *Moreno* at least for the reasons given above. The addition of *Muhme* does not render claim 4 obvious. *Muhme* merely discloses a system that

reads ID tags on items and determines whether the items may be removed from a secure location. (*Muhme*, Abstract.) It does not teach or suggest automatically sensing status information about a customer's use of a piece of rental equipment from the piece or rental equipment when it is returned or billing the customer for use of the piece of equipment based on the status information sensed from the piece of rental equipment, as recited by claim 4 by virtue of its dependence from claim 1. Accordingly, Applicant requests the withdrawal of the section 103 rejection of claim 4.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.



Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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